

REMARKS

In the Office Action, the Examiner: (1) required restriction under 35 U.S.C. §121 to either claims 1-25 or claims 26-52; (2) withdrew claims 26-52 from further consideration in light of the provisional election with traverse made by Applicant's representative on September 24, 2004; (3) rejected claims 1, 12, and 19 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,467,258 to Bamber et al. (hereinafter "Bamber"); (4) rejected claims 1-5, 11, 13, 18-21, and 24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,135,620 to Marsh (hereinafter "Marsh"); (5) rejected claims 1-4, 7-13, 19, 21, and 24 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,612,713 to Kuelbs (hereinafter "Kuelbs"); and (6) rejected claims 1, 2, 4-6, 13-18, and 21-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,381,124 to Whitcher et al. (hereinafter "Whitcher") in view of U.S. Patent No. 6,596,571 to Arao et al. (hereinafter "Arao").

In this response, Applicant has amended claims 1, 18, and 21 to further articulate novel aspects. New claims 53-85 have been added. No claims have been cancelled, and no new matter has been introduced. Upon entry of the claim amendments into the record, claims 1-25 and 53-85 will be pending. Claims 1, 21, 73, and 83 are in independent form.

Restriction Requirement

On page 2 of the Office Action, the Examiner required restriction under 35 U.S.C. §121 either to claims 1-25 (Group I) or to claims 26-52 (Group II). The Examiner alleged that the inventions defined by the claim groups are distinct because the apparatus of claims 1-25 can be used to practice another and materially different process, namely signaling someone. During a telephone conversation between the Examiner and Applicant's representative on September 24, 2004, Applicant's representative provisionally elected claims 1-25 (Group I) with traverse. Applicant hereby affirms the provisional election of claims 1-25 with traverse.

Applicant respectfully requests reconsideration of the restriction requirement. “If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” MPEP §803. In the instant case, the search and examination of method claims 26-52 (especially claims 26-38) can be made without serious burden because of their relatedness to apparatus claims 1-25. The subject matter of claims 1-25 and claims 26-52 is sufficiently related that a thorough search and examination related to apparatus claims 1-25 (directed to a light therapy apparatus for delivering ocular light to a subject to treat disorders that are responsive to ocular light therapy) would reasonably be expected to cover the subject matter recited in the related method claims (which are directed to a method of light therapy wherein ocular light is provided to a subject to treat disorders that are responsive to ocular light therapy). Thus, a search and examination of claims 1-52 together would not impose serious burden on the Examiner, and Applicant respectfully requests that the restriction requirement be withdrawn.

#### Claim Rejections Under 35 U.S.C. §§102 and 103

In the Office Action, the Examiner: (1) rejected claims 1, 12, and 19 under 35 U.S.C. §102(b) as being anticipated by Bamber; (2) rejected claims 1-5, 11, 13, 18-21, and 24 under 35 U.S.C. §102(b) as being anticipated by Marsh; (3) rejected claims 1-4, 7-13, 19, 21, and 24 under 35 U.S.C. §102(e) as being anticipated by Kuelbs; and (4) rejected claims 1, 2, 4-6, 13-18, and 21-25 under 35 U.S.C. §103(a) as being unpatentable over Whitcher in view of Arao. Applicant has amended independent claims 1 and 21 to recite claim limitations not disclosed, taught, or suggested by the prior art of record. Claim 1 as amended recites, among other limitations, the claim limitation of “...wherein the hand-held light output device is configured to emit therapeutic ocular light.” Similarly, claim 21 as amended recites the claim limitation of “...wherein the light source is configured to emit therapeutic ocular light.”

Not one of the cited prior art references discloses, teaches, or suggests the claim

limitation of a light source being configured to emit therapeutic ocular light. As disclosed in Applicant's specification, the claimed apparatus is capable of providing light intensities that are adequate for most light therapy applications (paragraph 0026 of Applicant's specification). In contrast, the prior art of record fails to teach or suggest the delivery of light intensities that are suitable for ocular light therapy.

Bamber merely discloses a flashlight having two selectable light sources (Abstract of Bamber). However, there is no teaching or suggestion in Bamber of the flashlight being configured to emit therapeutic ocular light. Marsh merely discloses a cold cathode fluorescent lamp apparatus for use in exit signs and traffic signals (Abstract of Marsh). However, there is no teaching or suggestion in Marsh of the CCFL apparatus being configured to emit therapeutic ocular light. In fact, Marsh teaches away from the use of light intensities suitable for ocular light therapy by touting the power consumption features of the CCFL apparatus as compared to other types of relatively low-intensity lighting assemblies, such as those used in exit signs (Abstract and col. 3, lines 38-43 of Marsh).

Kuelbs merely discloses a lawn or patio umbrella having an integral lighting system for providing high-intensity outdoor lighting for reading and other activities (Abstract of Kuelbs). However, there is no teaching or suggestion in Marsh of the patio umbrella being configured to emit therapeutic ocular light. The term "therapy" is not even mentioned in Kuelbs. Moreover, the patio umbrella disclosed in Kuelbs is not hand-held as recited in claim 1. In contrast, Kuelbs teaches that the pole of the patio umbrella is to be mounted in a base or in some other support structure such as a table or the ground (col. 3, lines 33-48 of Kuelbs). Clearly, Bamber, Marsh, and Kuelbs do not disclose, teach, or suggest each and every claim limitation recited in claims 1 and 21 as amended. (MPEP §2131). Therefore, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. §102 rejections of independent claims 1 and 21.

Whitcher and Arao, taken either alone or in combination, also fail to teach or suggest the claim limitation of a light source configured to emit therapeutic ocular light. Whitcher

merely discloses a hand-held computer system having a display screen (Figures 1 and 2 and the Abstract of Whitcher). The screen is an LCD color monitor having CCFL backlight (col. 6, lines 13-23 of Whitcher). However, Whitcher does not contain any teaching or suggestion of the screen being capable of delivering therapeutic ocular light. As those skilled in the art will readily understand, computer screens, and especially hand-held computer screens, are typically designed to provide a viewable picture using as little power as possible. Thus, the handheld computer system of Whitcher, which is primarily directed to being able to withstand a shock produced by a fall to the ground (col. 6, lines 8-13 of Whitcher), is completely unrelated to ocular light therapy and does not contain any teaching or suggestion of being configured to emit therapeutic ocular light.

Arao fails to cure this deficiency. Arao merely discloses a method of manufacturing a semiconductor device, which semiconductor device may be used in LCD apparatuses (Abstract, col. 31, lines 31-45 of Arao). However, Arao does not disclose, teach, or suggest the emission of therapeutic ocular light. Accordingly, the combination of Whitcher and Arao suggested by the Examiner also fails to teach or suggest the claim limitation of a light source configured to emit therapeutic ocular light. Whitcher and Arao are completely unrelated to ocular light therapy devices and do not even mention the term “therapy.”

For the foregoing reasons, Whitcher and Arao, taken either alone or in combination, do not teach or suggest each and every claim limitation recited in claims 1 and 21 as amended. (MPEP § 2143.03). Therefore, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. §103 rejection of claim 1 and 21, which are believed to be in condition for allowance.

Dependent claims 2-20 and 22-25 are in condition for allowance by way of their dependencies from independent claims 1 and 21. Nevertheless, the dependent claims also independently recite patentable subject matter. Merely by way of example, claim 10 recites the claim limitation of “a lens between the LED devices and the subject to diffuse the therapeutic light.” The Office Action relies solely upon Kuelbs to reject claim 10 under 35

U.S.C. §102(b) (page 3 of the Office Action). From the Office Action, Applicant cannot ascertain which element of Kuelbs is being relied upon to reject the lens recited in claim 10. Kuelbs does not disclose, teach, or suggest a lens for diffusing light emitted from the light assembly of the patio umbrella. Kuelbs does not even mention the term “lens.” Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 10.

By way of another example, Applicant has amended claim 18 to recite the claim limitation of “a manual timer device connected to the power supply for manually operating the light therapy device to emit the therapeutic ocular light for a selected period of time.” (Amendment emphasized). On page 4 of the Office Action, the Examiner takes Official Notice that timers that turn off displays after a predetermined time of inactivity are notorious in the art. Even if it is assumed for sake of argument that the taking of Official Notice is somehow appropriate, the use of screen savers and other power saving devices have nothing to do with a manual timer for operating a light therapy device to emit therapeutic ocular light for a manually selected period of time. None of the other cited references cure this deficiency because the references do not teach or suggest the emission of therapeutic ocular light, as discussed above. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections of claim 18. If the Examiner should continue to rely upon the taking of Official Notice, Applicants respectfully request that the Examiner provide documentary evidence pursuant to MPEP §2144.03.

Applicants respectfully submit that new claims 53-85 recite subject matter that is patentable over the prior art of record. With respect to new dependent claims 53-72, these claims are in condition for allowance by way of their dependencies from independent claim 1. In addition, claims 53-72 recite independently patentable subject matter not disclosed, taught, or suggested in the prior art of record. Merely by way of example, claim 56 recites a hand-held light output device configured to emit therapeutic ocular light at an intensity in the range of 1,000 lux to 2,000 lux at 6 to 12 inches from a light output device. The cited prior art of record does not teach or suggest this claim limitation. By way of another example,

claim 63 recites a hand-held light output device configured to reduce or increase the therapeutic ocular light to simulate gradually decreasing light at dusk or gradually increasing light at dawn, respectively. The cited prior art of record does not teach or suggest this claim limitation. By way of yet another example, claim 70, which depends from claim 1, recites a housing including a transition member configured to transition from a closed position to an open position. The transition member is further claimed to provide a cover for light sources when in the closed position and a base for the light therapy device when in the open position. The prior art of record does not teach or suggest this claim limitation as recited in claim 68.

With respect to new claims 73-85, these claims are in condition for allowance at least for the reasons discussed above in relation to independent claims 1 and 21 because new independent claims 73 and 85 each recites the claim limitation of a light source configured to emit therapeutic ocular light. In addition, similar to claim 70, claim 83 recites a housing including a transition member configured to transition from a closed cover position to an open base position, which limitation is not taught or suggested in the prior art of record. Claims 74-82, 84, and 85 are in condition for allowance by way of their respective dependencies from independent claims 73 and 83. In addition, claims 74-82, 84, and 85 recite independently patentable subject matter not disclosed, taught, or suggested in the prior art of record.

For at least the foregoing reasons, Applicant respectfully submits that new claims 53-85 are fully supported by Applicant's disclosure and are patentable over the prior art of record.

CONCLUSION

For the foregoing reasons, the present application is considered to be in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper, which fees have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

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Jeffrey R. Jeppsen  
Registration No. 53,072

Jeffrey R. Jeppsen  
**Rader Fishman & Grauer PLLC**  
River Park Corporate Center One  
10653 S. River Front Parkway, Suite 150  
South Jordan, Utah 84095  
(801) 572-0185  
(801) 572-7666 (fax)